

REMARKS:

Claims 1-29 are currently pending in the application.

Claims 1, 4-10, 13-19, and 22-29 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2002/0035511 A1 to Haji et al. ("*Haji*") in view of U.S. Patent No. 6,260,024 to Shkedy ("*Shkedy*") and in further view of U.S. Patent No. 6,105,004 to Halperin et al. ("*Halperin*").

Claims 2, 11, and 20 stand rejected under 35 U.S.C. § 103(a) over *Haji* in view of *Shkedy* and *Halperin* and in further view of Official Notice.

Applicant respectfully submits that all of Applicant's arguments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner's rejections.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1, 4-10, 13-19, and 22-29 stand rejected under 35 U.S.C. § 103(a) over *Haji* in view of *Shkedy* and in further view of *Halperin*.

Claims 2, 11, and 20 stand rejected under 35 U.S.C. § 103(a) over *Haji* in view of *Shkedy* and *Halperin* and in further view of Official Notice.

Applicant respectfully submits that the proposed combination of *Haji*, *Shkedy*, or *Halperin*, either individually or in combination, fails to disclose each and every limitation recited by Claims 1, 4-10, 13-19, and 22-29. Applicant further respectfully submits that the proposed combination of *Haji*, *Shkedy*, *Halperin*, or the Examiner's Official Notice, either individually or in combination, fails to disclose each and every limitation recited by Claims 2, 11, and 20. Thus, Applicant respectfully traverses the Examiner's obvious rejection of Claims 1-29 under 35 U.S.C. § 103(a)

over the proposed combination of *Haji*, *Shkedy*, *Halperin*, or the Examiner's Official Notice, either individually or in combination.

The Proposed *Haji-Shkedy-Halperin* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to independent Claim 1, this claim recites:

A *system for locally generating price quotes*, the system comprising:
a *network coupled with a plurality of buyers and a plurality of sellers*;
a *database associated with each of the plurality of buyers*; and
a *server associated with each of the plurality of buyers*, wherein the server is operable to:

receive one or more pricing tools from one or more of the plurality of sellers, the one or more pricing tools operable to generate one or more price quotes for one or more corresponding sellers;

locally store the one or more pricing tools received from one or more of the plurality of sellers in the database, such that the one or more pricing tools are locally accessible to the server;

access a request for quote (RFQ) specifying an order comprising quantities of one or more items, the RFQ requesting a price quote for the order;

communicate the RFQ to the locally accessible one or more pricing tools;

using the locally accessible one or more pricing tools received from one or more of the plurality of sellers, locally generate one or more price quotes for the order; and

provide the locally generated one or more price quotes for the order for possible further action by the buyer. (Emphasis Added).

In addition, *Haji*, *Shkedy*, or *Halperin*, either individually or in combination, fail to disclose each and every limitation of independent Claims 10, 19, 28, and 29.

The Office Action Acknowledges that *Haji* Fails to Disclose Various Limitations Recited in Applicant's Claims

Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that *Haji* fails to disclose various limitations recited in independent claim 1. Specifically the Examiner acknowledges that *Haji* fails to teach a “*network coupled with a plurality of buyers and a plurality of sellers, and a database associated with each of the plurality of buyers*”. (21 March 2008 Final Office Action, Page 5). (Emphasis added). However, the Examiner asserts that the cited

portions of *Shkedy* disclose the acknowledged shortcomings in *Haji*. Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Shkedy*.

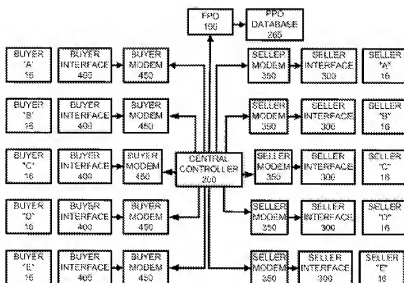
In particular, the Examiner states:

Haji does not specifically teach a ***network coupled with a plurality of buyers and a plurality of sellers, and a database associated with each of the plurality of buyers***. However, Shkedy teaches this matter (Figs. 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made ***to allow buyers and sellers in Haji's teaching to be coupled to a network and the buyers information are stored in a database for better centralize transactions***.

(21 March 2008 Final Office Action, Page 5). (Emphasis added). By contrast the cited portion of *Shkedy* on which the Examiner relies does not disclose a ***"network coupled with a plurality of buyers and a plurality of sellers"*** and a ***"database associated with each of the plurality of buyers"***, as recited in independent Claim 1, but rather merely describes a network that requires an ***"intermediary"***. For example, Applicant respectfully directs the Examiner's attention to *Shkedy* "Field of the Invention" section:

The method and apparatus of the present invention relates to electronic commerce network applications and, more particularly, to a system and method for facilitating a transaction between a plurality of buyers, ***an intermediary***, and a plurality of sellers over an electronic network.

(Column 1, lines 8-12.) (Emphasis added). As clearly shown above, *Shkedy* makes clear that *Shkedy* merely facilitates a "transaction between a plurality of buyers, ***an intermediary***, and a plurality of sellers over an electronic network." (Column 1, lines 8-12.) (Emphasis added). Therefore, the ***"intermediary"*** as disclosed in *Shkedy*, does not equate to the ***"network"***, as recited in independent Claim 1. In fact, Applicant respectfully directs the Examiner's attention to Figure 1, on which the Examiner relies:



Applicant respectfully submits that the Examiner has mischaracterized Figure 1 and the cited portion of *Shkedy*. In fact, Applicant finds no such teachings anywhere in *Shkedy* of a “network coupled with a plurality of buyers and a plurality of sellers” and a “database associated with each of the plurality of buyers” and certainly not in the cited columns and lines of *Shkedy*, cited by the Examiner. For example, Applicant respectfully directs the Examiner’s attention to the cited portion of *Shkedy*, on which the Examiner relies:

FIG. 1 illustrates a plurality of buyers electronically coupled to *central controller [intermediary] 200* with buyer modems 450, the *central controller [intermediary] 200* is electronically coupled to a plurality of seller [sic] through seller modems 350 and sellers 300. Each of the plurality of buyers who wish to make purchases independently access the *central controller [intermediary] 200* to create forward purchase orders (FPOs) to submit their purchase orders for items and/or services. The *central controller [intermediary] 200* is preferably located at a remote server.

(Column 4, line 65 through column 5, line 6). (Emphasis added). As clearly shown in Figure 1 of *Shkedy* and by the cited portions of *Shkedy*, *Shkedy* does not teach, suggest, or even hint at a “network coupled with a plurality of buyers and a plurality of seller”, as asserted by the Examiner, but merely “illustrates a plurality of buyers electronically coupled to *central controller [intermediary] 200* with buyer modems 450, the *central controller [intermediary] 200* is

electronically coupled to a plurality of seller [sic] through seller modems 350 and sellers 300.” (Column 4, line 65 through column 5, line 2). (Emphasis Added).

At most, *Shkedy* merely teaches that a “**central controller [intermediary] 200**” is coupled to a “plurality of buyers” and a “plurality of seller[s]” over a network. (Column 4, line 65 through column 5, line 6). (Emphasis Added). Therefore, the cited portions of *Shkedy* on which the Examiner relies, clearly does not disclose a “**network coupled with a plurality of buyers and a plurality of sellers**” or even any type of network, but rather merely discloses that a “**central controller [intermediary] 200**” that is coupled with a “plurality of buyers” and a “plurality of seller[s]” over a network, or put another way, the network as disclosed in *Shkedy* clearly does not equate to a “**network coupled with a plurality of buyers and a plurality of sellers**”. Applicant respectfully requests the Examiner to verify the references to *Shkedy*, to ensure that some mistake has not been made.

In addition, as noted above, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made ***to allow buyers and sellers in Haji’s teaching to be coupled to a network and the buyers information are stored in a database for better centralize transactions.***

(21 March 2008 Final Office Action, Page 5). (Emphasis added). Applicant respectfully disagrees and respectfully submits that Applicant finds no such teachings anywhere in *Shkedy* and certainly not in the cited portions of *Shkedy*, relied upon by the Examiner. In fact, Applicant respectfully directs the Examiner’s attention to Figure 2, on which the Examiner relies:

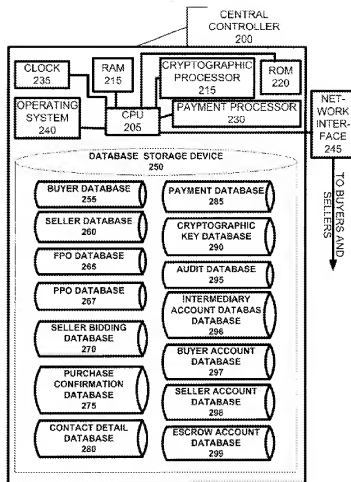


FIG. 2

Applicant respectfully submits that the Examiner has mischaracterized Figure 2 and the cited portion of *Shkedy*. As clearly shown in Figure 2 of *Shkedy*, *Shkedy actually teaches away from independent Claim 1*. For example, Figure 2 of *Shkedy* does not teach a “database associated with each of the plurality of buyers”, as asserted by the Examiner, but rather shows a single “database storage device 250” associated *only* with the “central controller [intermediary] 200” of Figure 1. (Column 4, line 65 through column 5, line 6 and column 9, lines 54-67). (Emphasis added). In fact, Figure 2 of *Shkedy* is merely a block diagram showing “central controller [intermediary] 200” of Figure 1, which as discussed above, is *not* a plurality of buyers or even a buyer, but rather is merely an “intermediary”. (Column 9, lines 54-67). (Emphasis added).

As discussed above, the Examiner states, that *Shkedy* discloses a “database associated with each of the plurality of buyers”, that is, the Examiner equates the “database” recited in independent

Claim 1 with the “**database storage device 250**” disclosed in *Shkedy*. (21 March 2008 Final Office Action, Page 5). Applicant respectfully submits that this equation is inaccurate, that is the “**database storage device 250**” as disclosed in *Shkedy*, does not equate to “**database**” as recited in independent Claim 1 because, among other things, the “**database storage device 250**” of *Shkedy* is only associated with the “**central controller [intermediary] 200**” of Figure 1 and not “**each of the plurality of buyers**”, as recited in independent Claim 1.

In addition, *Shkedy* makes clear that the seller of *Shkedy* is merely dealing with the “**intermediary**” of *Shkedy* and **not with the buyer** of *Shkedy*. For example, Applicant respectfully directs the examiner’s attention to *Shkedy*:

The seller has now entered into a legally binding contract with the intermediary.

(Column 6, lines 27-28). As clearly shown in the cited portion of *Shkedy*, *Shkedy* provides for the seller of *Shkedy* to enter into a contract with the “**intermediary**” of *Shkedy*, and not the buyer of *Shkedy*. Applicant respectfully requests the Examiner to verify the references to *Shkedy*, to ensure that some mistake has not been made.

In addition, as discussed above, the Examiner states:

... to allow buyers and sellers in Haji’s teaching to be coupled to a network and the buyers information are stored in a database for better centralize transaction.

(21 March 2008 Final Office Action, Page 5). (Emphasis added). Applicant respectfully submits that the Examiner has mischaracterized independent Claim 1, that is, independent Claim 1 recites, *inter alia*, “**locally store the one or more pricing tools received from one or more of the plurality of sellers in the database [associated with each of the plurality of buyers]**, such that the one or more pricing tools are locally accessible to the server **[associated with each of the plurality of buyers]**” and not “**the buyers information are stored in a database for better centralize transaction**”, as asserted by the Examiner. (21 March 2008 Final Office Action, Page 5). (Emphasis added). Thus, Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Shkedy* and independent Claim 1 cannot be made. Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Shkedy*.

The Office Action Acknowledges that the proposed *Haji-Shkedy* Combination Fails to Disclose Various Limitations Recited in Applicant's Claims

Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that the proposed combination of *Haji* and *Shkedy* fails to disclose various limitations recited in independent Claim 1. Specifically the Examiner acknowledges that the proposed combination of *Haji* and *Shkedy* fails to teach “the specified order comprising *quantities of one or more items*”. (21 March 2008 Final Office Action, Page 5). However, the Examiner asserts that the cited portions of *Halperin* disclose the acknowledged shortcomings in *Haji* and *Shkedy*. Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Halperin*.

Applicant respectfully submits that *Halperin* fails to disclose, teach, or suggest independent Claim 1 limitations regarding “*access[ing] a request for quote (RFQ) specifying an order comprising quantities of one or more items*, the RFQ requesting a price quote for the order”. In particular, the Examiner equates “*quantities of one or more items*” recited in independent Claim 1 with the “*purchase information*” disclosed in *Halperin*. (21 March 2008 Final Office Action, Page 5). However, the “*purchase information*” disclosed in *Halperin* is merely displayed on a screen, but *does not include, involve, or even relate to the quantities of one or more items*, as recited in independent Claim 1. (Column 4, Lines 1-4). In contrast, the “*quantities of one or more items*” recited in independent claim 1 *is associated with a buyer for locally generating price quotes wherein a request for quote is accessed specifying an order which comprises quantities of one or more items*. Thus, Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Halperin* and independent Claim 1 cannot be made. Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Halperin*.

The Proposed *Haji-Shkedy-Halperin*-Official-Notice Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 2, 11, and 20

For example, with respect to dependent claim 2, this claim recites:

The system of Claim 1, wherein the *one or more pricing tools are encrypted* to prevent the one or more pricing tools from being used to determine how price quotes are calculated. (Emphasis Added).

In addition, *Haji, Shkedy, Halperin*, or the Examiner's Official Notice, either individually or in combination, fail to disclose each and every limitation of dependent claims 11 and 20.

The Office Action Acknowledges that the proposed *Haji-Shkedy-Halperin* Combination Fails to Disclose Various Limitations Recited in Applicant's Dependent Claims

Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that the proposed combination of *Haji, Shkedy*, and *Halperin* fails to disclose various limitations recited in dependent claim 2. Specifically the Examiner acknowledges that the proposed combination of *Haji, Shkedy*, and *Halperin* fails to teach "the pricing tools are encrypted to prevent the pricing tool from being used to determine how price quotes are calculated". (21 March 2008 Final Office Action, Page 7). However, the Examiner asserts Official Notice over the acknowledged shortcomings in *Haji* and *Shkedy*. Applicant respectfully traverses the Examiner's Official Notice.

The Examiner's *Official-Notice* is improper under MPEP § 2144.03

Applicant respectfully submits that Applicant is confused as to what the Examiner teaches by the Official Notice or even to the extent in which the Examiner is taking Official Notice. Applicant respectfully requests clarification as to the subject matter for which Official Notice is being taken. *Applicant respectfully traverses the Official Notice because the asserted facts*, as best understood by Applicant, *are not supported by substantial documentary evidence or any type of documentary evidence* and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion. (See MPEP § 2144.03). *Applicant respectfully requests the Examiner to produce authority for the Examiners Official Notice.*

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection". (MPEP § 2144.03). "Official notice unsupported by documentary evidence *should only be taken by the examiner* where the facts asserted to be well-known, or to be common knowledge in the art are *capable of instant and unquestionable demonstration as being well-known*."

With respect to the subject Application, the Examiner's statement that the "Examiner takes Official Notice that encrypting information for preventing unauthorized parties from revealing the information is old and well known in the art" and that "Examiner takes Official Notice that encrypting information for preventing unauthorized parties from revealing the information is old and well known in the art", ***is not capable of instant and unquestionable demonstration as being well-known.*** (21 March 2008 Final Office Action, Pages 7-8). As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '***capable of such instant and unquestionable demonstration as to defy the dispute***' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"It is ***never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record,*** as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)." (MPEP § 2144.03(A)).

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that ***general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection***). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. Applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." (MPEP § 2144.03(B)). (Emphasis Added).

With respect to the subject application, the Examiner states:

Tsiounis teaches encrypting information and data encryptions are well known in the art (§ 17, 40). Therefore, it would have been obvious to one of ordinary skill in the art to allow the pricing tools in the teachings of Haji modified by Shkedy and Halperin to be encrypted for better protecting the information associated with the pricing tools.

(21 March 2008 Final Office Action, Page 8). By contrast, the cited portion of *Tsiounis* on which the Examiner relies does not disclose “wherein the **one or more pricing tools are encrypted** to prevent the one or more pricing tools from being used to determine how price quotes are calculated”, as recited in dependent Claim 2, but rather *Tsiounis* merely states that “**credit card information is sent encrypted between the user and the merchant and is verified at the clearing house**”. (§ 17). (Emphasis added). In fact, Applicant respectfully directs the Examiner’s attention to the cited portions of *Tsiounis* on which the Examiner relies:

Secure Electronic Transactions is a system designed by MasterCard and Visa to allow secure credit card transactions over the Internet. The system requires credit card clearing houses, merchants and **users to download and install the appropriate software**. The **credit card information is sent encrypted between the user and the merchant and is verified at the clearing house**, without exposing it to other users of the Internet or to the merchant himself. Digital signatures authenticate each transaction for future auditing.

(§ 17). (Emphasis added). Therefore, *Tsiounis* fails to provide documentary evidence to support the Official Notice taken by the Examiner, that is, “Examiner takes Official Notice that encrypting information for preventing unauthorized parties from revealing the information is old and well known in the art” because it is simply not capable of “instant and unquestionable” demonstration as being well-known. (21 March 2008 Final Office Action, Pages 7-8). Applicant further respectfully submits that Applicant has adequately traversed the Examiners assertion of Official Notice and direct the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or

declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of Claims 1-29 based on the Official Notice, Applicant respectfully requests that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, Applicant further respectfully requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Haji-Shkedy-Halperin*-Official-Notice Combination According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Haji, Shkedy, Halperin*, or the Examiner's Official Notice, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" (the "Guidelines").

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, "While the sequence of these questions might be reordered in

any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “**ensure that the written record includes findings of fact** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “**factual findings made by Office personnel are the necessary underpinnings to establish obviousness.**” (*id.*). Further, “**Office personnel must provide an explanation to support an obviousness rejection** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that Applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the **factual findings necessary to establish obviousness** or even **an explanation to support the obviousness rejection** based on the proposed combination of *Haji*, *Shkedy*, *Halperin*, and the Examiner’s Official Notice. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art to allow the pricing tools in the teachings of *Haji* modified by *Shkedy* and *Halperin* to be encrypted”. (21 March 2008 Final Office Action, Pages 8). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the **factual findings necessary to establish obviousness** and is not a sufficient **explanation to support the obviousness rejection** based on the proposed combination of *Haji*, *Shkedy*, *Halperin*, and the Examiner’s Official Notice.

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (*See Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “**obviousness rejection should include**, either explicitly or

implicitly in view of the prior art applied, ***an indication of the level of ordinary skill.***” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided ***an indication of the level of ordinary skill.***

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. (Id.).*** In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. (Id. and See 35 U.S.C. 103(a)).***

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant’s invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain why the difference(s) between the proposed combination of Haji, Shkedy, Halperin, the Examiner’s Official Notice and Applicant’s claimed invention would have been obvious to one of ordinary skill in the art.*** The Office Action merely states that “for better protecting the information associated with the pricing tools”. (21 March 2008 Final Office Action, Pages 8). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement ***explains why the difference(s) between the proposed combination of Haji, Shkedy, Halperin, the Examiner’s Official Notice and Applicant’s claimed invention would have been obvious to one of ordinary skill in the art.*** Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that ***“the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (id.).*** The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that ***“[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there***

must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”” (KSR, 550 U.S. at __, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant’s claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection and combination of Haji, Shkedy, Halperin, and the Examiner’s Official Notice to render obvious Applicant’s claimed invention*. The Examiner’s unsupported conclusory statements that “it would have been obvious to one of ordinary skill in the art to allow the pricing tools in the teachings of *Haji* modified by *Shkedy* and *Halperin* to be encrypted” and “for better protecting the information associated with the pricing tools”, *does not adequately provide clear articulation of the reasons why Applicant’s claimed invention would have been obvious*. (21 March 2008 Final Office Action, Pages 8). Applicant respectfully disagrees. For example, how does “*better protecting the information*” prevent the one or more pricing tools from being used to determine how price quotes are calculated and to what extent does the Examiner purport that “*better protecting the information*” applies to the subject Application. In addition, the Examiner’s unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicant’s claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Haji, Shkedy, Halperin*, and the Examiner's Official Notice, *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines.*

Applicant's Claims are Patentable over the Proposed *Haji-Shkedy-Halperin*-Official-Notice Combination

Independent Claims 10, 19, 28, and 29 are considered patentably distinguishable over the proposed combination of *Haji, Shkedy*, and *Halperin*, for at least the reasons discussed above in connection with independent Claim 1.

Furthermore, with respect to dependent Claims 2-9, 11-18, and 20-27: Claims 2-9 depend from independent Claim 1; Claims 11-18 depend from independent Claim 10; and Claims 20-27 depend from independent Claim 19. As mentioned above, each of independent Claims 1, 10, 19, 28, and 29 are considered distinguishable over *Haji, Shkedy*, or *Halperin*. Thus, dependent Claims 2-9, 11-18, and 20-27 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 1-29 are not rendered obvious by the proposed combination of *Haji, Shkedy, Halperin*, and the Examiner's Official Notice. Applicant further respectfully submits that Claims 1-29 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 1-29 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-29 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed electronically herewith to facilitate the processing of this deposit account authorization. **The Director is hereby authorized to charge the \$810.00 RCE fee to Deposit Account No. 500777.** Although Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777.** If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777.**

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

23 June 2008
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

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